

Serial No. 09/726,142

### REMARKS

This amendment is responsive to the official action dated October 6, 2003.

Claims 9 and 10 were pending in the application. Claims 9 and 10 were rejected. No claims were allowed by the Examiner.

By way of this amendment, the specification has been amended to include the required priority claim. Claims 9 and 10 remain unchanged.

Accordingly, Claims 9 and 10 are currently pending.

I. REJECTION OF CLAIMS UNDER 35 USC 102

Claims 9-10 were rejected under 35 USC 102(e), as being anticipated by US Patent No. 6,410,847 (Allen et al.), filed July 25, 2000. The Applicant directs the Examiner's attention to the fact that the present invention claims priority to a provisional application that was filed December 1, 1999. The Applicant has amended the specification to include a statement regarding this priority claim. Since the effective filing date of the present invention predates the filing date of the cited reference, the Applicant asserts that the cited reference is disqualified and not considered valid prior art in this application.

Since the present application has a filing date that predates the filing date of the Allen reference, the rejection can no longer be maintained. Reconsideration and withdrawal of the rejection is respectfully solicited.

II. REJECTION OF CLAIMS UNDER 35 USC 103

The Examiner rejected Claims 9 and 10 under 35 USC §103 (a) as being obvious and unpatentable over the combination of US Patent No. 5,100,726 (Nakagawa) in view of US Patent No. 6,049,469 (Hood, III). The Examiner stated that Nakagawa teaches a process including the steps of providing a base thermoplastic polymer matrix, mixing a thermally conductive filler into said base matrix, injection molding the mixture into a net-shape molded configuration having a contact surface and installing a metallic plate over the part. The Examiner further states that while Nakagawa does not disclose the

Serial No. 09/726,142

inclusion of an outer surface and a contact interface for flush thermal communication with a heat generating object, Hood discloses a well known shield for dissipating heat and providing protection from electromagnetic interference and that it would have been obvious to one skilled in the art to combine the references to arrive at the present invention.

The Applicant asserts however that the device disclosed in Nakagawa specifically teaches away from the method and composition disclosed under the present invention. The Nakagawa reference specifically discloses that the carbon fiber reinforcing used in the polymer matrix is not pitch based. Specifically, the disclosure requires that the carbon fiber cannot evaporate at temperatures of between 950°C and 1300°C where per the disclosure the specialized carbon fiber is pyrolyzed. The invention is directed at forming an electrically conductive housing that by its very nature is not thermally conductive.

In order to be thermally conductive, the carbon filler used must be a pitch based product. The disclosure in Nakagawa specifically excludes pitch based carbon because it would evaporate at the temperatures required to accomplish the pyrolyzation process central to the operation of the Nakagawa process. Further, the disclosure lacks any reference to forming integral interface pads as a part of the device structure.

With respect to the Hood disclosure, the shield device is exactly the type of device that the present invention is created to overcome. The shield cannot be net shape molded. It must be stamped and machined. Further, while it includes finger that extend downwardly to contact the surfaces of the devices it clearly could not be formed using net shape molding processes.

There is no teaching within Hood that the device could be formed using any other process other than a process that involves the stamping of metal. Since neither of the cited references include any teachings that suggest that they could be combined to form an integrated structure and since even the integrated structure would be lacking in the critical thermally conductive polymer composition that is central to the present invention,

Serial No. 09/726,142

it is believed that the cited references could not be combined to arrive at the present invention. In other words, since Nakagawa specifically teaches away from using a thermally conductive type carbon filler in the polymer composition, the two cited references cannot be combined to render the present invention obvious nor would one having skill in the relevant art have motivation to combine these two divergent references.

Since there is no teaching in either of the cited references alone or in combination that render the present invention obvious the Applicant asserts that this rejection is inapplicable and respectfully requests withdrawal of this grounds for rejection.

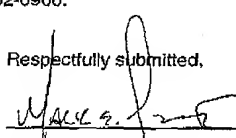
### III. CONCLUSION

Accordingly, claims 9 and 10 are believed to be in condition for allowance and the application ready for issue.

Corresponding action is respectfully solicited.

PTO is authorized to charge any additional fees incurred as a result of the filing hereof or credit any overpayment to our account #02-0900.

Respectfully submitted,

  
Mark E. Tetreault, Esq.  
Reg. No. 48,289

BARLOW, JOSEPHS & HOLMES, Ltd.  
101 Dyer Street, 5<sup>th</sup> Floor  
Providence, RI 02903  
(401) 273-4446 (tel)  
(401) 273-4447 (fax)  
met@barjos.com